

### **REMARKS**

Claims 36-80 are pending, with claims 36, 47, and 68 being independent. Claims 75-80 have been added. In view of the following remarks, reconsideration and allowance of this application are respectfully requested.

#### **Examiner Interview**

Applicants thank Examiners April Baugh and Le Luu for the courtesy of a personal interview held with Applicants' representative on February 3, 2005. During the interview, Applicants' representative provided the Examiners with clean copies of claims 36 and 68 and a copy of page 3 of Applicants' Reply to Action of May 7, 2004, which was filed on September 7, 2004 (the "September 7, 2004 Reply"). Applicants' representative explained to the Examiners various aspects of claims 36, 47, and 68. Applicants' representative also explained why Applicants believe the rejections of independent claims 36, 47, and 68 to be improper. The substance of Applicants' arguments and the Examiners' responses to those arguments, is incorporated into the remarks below.

#### **35 U.S.C. § 102(e) Appelman Rejection**

Claim 68 was rejected under 35 U.S.C. § 102(e) as being anticipated by Appelman (U.S. Patent No. 6,677,968). Applicants respectfully request withdrawal of this rejection.

Claim 68 is directed to a method of providing a buddy list to a network user, and recites, among other things, "receiving user definition of a first buddy list, the first buddy list comprising members defined by the network user," "receiving user definition of a second buddy list, the second buddy list comprising members defined by the network user," "triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list" and "displaying the selected buddy list to the network user on an instant messaging user interface." Applicants respectfully submit that Appelman does not describe or suggest at least these features of claim 68.

In particular, as Applicants' representative explained during the interview, Appelman does not describe or suggest at least receiving user definition of a first and a second "buddy list," or triggering display of one of the "buddy lists" based on user input. As explained on page 3 of

the September 7, 2004 Reply and as reiterated during the interview, the term “buddy list” in this application refers to an aggregated collection of online identifiers for whom online presence is reflected. This term is defined in Applicants’ specification as a list of “names of other server system users” and with reference to item 404 of Figure 4. (See Specification at page 3, lines 12-18). Notably, Figure 4 of this application makes clear that a buddy list includes one or more buddy groups, and that each buddy group can include one or more other buddies, necessarily distinguishing buddy lists, buddy groups, and buddies. This is consistent with the ordinary meaning ascribed to the term buddy list. To further clarify the meaning of the term buddy list, new dependent claims 79 and 80 recite that a “buddy list comprises one or more buddy groups defined by the network user” and that “members are grouped into the buddy groups by the network user,” respectively.

Appelman describes a system that tracks and displays, for a user, the logon status of co-users (i.e., buddies) on an online communications system, such as instant messaging. (Appelman at col. 2, lines 58-63). As discussed during the interview, it appears that the Examiner’s rejection relies upon Appelman’s disclosure of allowing a user to “define multiple buddy lists by group names.” (Appelman at col. 3, lines 48-49). However, as Applicants’ representative explained during the interview, Appelman ascribes a different definition to “buddy list” than the ordinary definition of buddy list used in this application. As shown in FIG. 2A, Appelman uses the term “buddy list” to refer to a list of buddies associated with a single buddy group, with all of the buddy groups stored in a Group Name table 30. (Id. at col. 3, lines 46-49). However, Appelman does not describe or suggest receiving user definition of, or selecting among, more than one “buddy list,” where the term buddy list encompasses an aggregate collection of buddies, including any buddy groups and associated lists of buddy names.<sup>1</sup>

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<sup>1</sup> The statement in the Examiner’s Interview Summary that “Applicant argues that the group name table is equivalent to the buddy list they are speaking of” does not precisely capture the nature of the argument set forth by Applicants’ representative. Rather, Applicants’ representative asserted that the term “buddy list,” as used in this application, refers to the aggregate collection of all buddy names and buddy groups, and could include, for example, all of the buddy group names and associated lists of buddies that are in a data structure like the Group Name table 30 in Appelman.

For at least these reasons, Appelman fails to anticipate independent claim 68. Accordingly, claim 68, and its dependent claims 69-74, are patentable over Appelman.

**35 U.S.C. § 103(a) Rejections**

Claims 36-67 and 74 have been rejected, under 35 U.S.C. § 103(a), as being obvious over Appelman in combination with one or more of Schindler (U.S. Patent No. 6,081,830), Porter (U.S. Patent No. 6,434,599), and DeSimone (U.S. Patent No. 6,212,548).

As agreed to during the Examiner interview, Appelman cannot be used as the basis of an obviousness rejection under 35 U.S.C. § 103(c). Appelman is prior art under § 102(e) and, at the time of the invention that is the subject of this application, both this application and Appelman were obligated to be assigned to the same entity, America Online, Inc. This is evidenced by the fact that this application and Appelman are both presently assigned to America Online, Inc. Accordingly, Applicants respectfully request withdrawal of the obviousness rejections of claims 36-67 and 74.

Applicants do not acquiesce to the characterizations of the art in the Office Action of November 18, 2004 and in the Examiner Interview Summary dated February 3, 2005. For example, during the Examiner Interview, Applicants did not agree that Schindler and Porter show "that a user can view a show and a buddy list can appear that corresponds with the viewed TV show so that the user can IM with others who are viewing the same TV show." (See Examiner's Interview Summary). For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

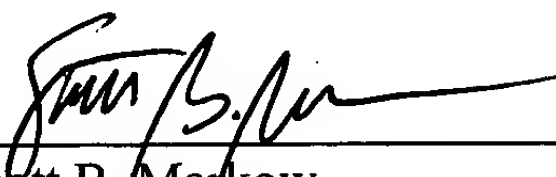
Enclosed is a \$300.00 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

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Respectfully submitted,

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